

REMARKS

Claims 1-36 are pending in this application.

Claims 1 and 19 have been amended in order to more particularly point out,
and distinctly claim the subject matter to which the Applicants regard as their
invention. It is believed that this Amendment is fully responsive to the Office Action
dated May 2, 2003.

Claim Rejections under 35 USC §112

**Claims 1-36 are rejected under 35 USC 112, first paragraph, because the
specification, while being enabling for the types of noise listed in Figs. 37A-37D,
does not reasonably provide enablement for other types of noise.**

Each kind of noise in claims 1 and 19 are amended to a plurality kinds of noise.
It is believed that this claim amendment eliminated the 112 first paragraph rejection.
Should the Office believe the same 112 first paragraph rejection still exist, an
explanation that fulfills the requirement of substantiating this rejection is respectfully
requested.

The requirement for making a burden of prove for a lack of enablement is
specifically stated in MPEP 2164.04. From reviewing this section, it is the
Applicant's understanding that to meet the initial burden to establish a reasonable
basis to question the enablement provided for the claimed invention, the Office
should:

1. construe the claims and take position on terms that may lend multiple meaning;

2. provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure;

3. explain why the Office doubts the truth or accuracy of any statement in a supporting disclosure;

4. back up assertions of the Office with acceptable evidence or reasoning which is inconsistent with the contested statement; and

5. Give reasons for the uncertainty of the enablement.

Should the Office be unable to meet the requirement of these tests, then the Office has not met its initial burden in asserting a lack of enablement rejection. There would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

Should the Office continue to maintain this rejection, explanations in compliance with MPEP 2164.04 are respectfully requested.

Claims 1-36 are rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Relevant claims have been amended, as needed, to overcome this rejection. Reconsideration and withdrawal of this rejection are respectfully requested.

Claim Rejections under 35 USC §103

Claims 1-6, 13, 19-24 and 31 are rejected under 35 USC §103(a) as being unpatentable over Purks (U.S. Patent No. 5,481,695) in view of Carlson et al. (U.S. Patent No. 6,128,769).

Pertaining to independent claims 1 and 19, the outstanding Office action has specifically stated that “Purks only expressly teaches cross-talk noise, and not other types of noise as claimed”. The Applicant agrees with this Office assessed shortcoming of Purks. However, these are not the only shortcomings of Purks in view of Carlson.

Independent claim 1 has specifically recited “synthesizing the signal waveform and the noise waveforms calculated for the individual of the plurality of kinds of noise with generation timings of the noise waveforms taken into consideration to obtain a noise composite waveform which is the signal waveform on which the noise is superposed”.

In neither Purks nor Carlson is there any disclosure or teaching of any synthesizing. Naturally, there also would not be any disclosure or teaching of synthesizing the signal waveform and the noise waveforms calculated for the individual of the plurality of kinds of noise with generation timings of the noise waveforms taken into consideration to obtain a noise composite waveform which is the signal waveform on which the noise is superposed.

Independent claim 19 has specifically recited “a noise waveform synthesis section for synthesizing the signal waveform and the noise waveforms calculated by said simulation section with generation timings of the noise waveforms taken into consideration to obtain a noise composite waveform which is the signal waveform on which the noise is superposed; and a noise checking section for performing noise checking based on the noise composite waveform obtained by said noise waveform synthesis section”.

In neither Purks nor Carlson is there any disclosure or teaching of any synthesizing or noise checking section. Naturally, there also would not be any disclosure or teaching of a noise waveform synthesis section for synthesizing the signal waveform and the noise waveforms calculated by said simulation section with generation timings of the noise waveforms taken into consideration to obtain a noise composite waveform which is the signal waveform on which the noise is superposed. There would also not be any disclosure or teaching of a noise checking section for performing noise checking based on the noise composite waveform obtained by said noise waveform synthesis section.

In the outstanding Office action, columns 3-5 have been extensively cited. There is some discussion on simulations. However, there are no discussion on synthesizing as well as noise checking. Therefore, even if the asserted prior art references are combined, exactly as suggested in the outstanding Office action, the synthesizing section and noise checking section as well as the inter-relationship

between these sections and other section would not result. Therefore, independent claims 1 and 19 are patentably distinguished over Purks and Carlson. All claims dependent thereon, by virtue of inherency, are also patentably distinguished over Purks and Carlson further in view of whatever other secondary reference.

Section 706.01(j) of the MPEP has specifically stated that:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 466, 20 USPQ2d 1438 (Fed. Cir. 1991).”

Therefore, it is both a court position and a Patent Office position that to establish a *prima facie* case of obviousness, 1) there **must be** some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there **must be** a reasonable expectation of success; and 3) the teaching or suggestion to make the claimed combination and the reasonable expectation of success **must both be** found in the prior art, and not based on applicant’s disclosure.

Therefore, should the Office either be unable to identified each and every aspect of the above-mentioned claimed features after taking full consideration of the asserted prior art in a way exactly applied in the outstanding Office action, or the

Office recognizes that the rejection simply does not arise to a level objectively fulfilling all three criteria of establishing a *prima facie* case of obviousness, it is respectfully submitted that the obviousness rejection is defective and allowance of the claimed invention is requested.

Claims 7-8 and 25-26 are rejected under 35 USC §103(a) as being unpatentable over Purks (U.S. Patent No. 5,481,695) in view of Carlson et al. (U.S. Patent No. 6,128,769) and further in view of Official Notice, and further in view of Rhodes ("Parallel Computation for Microwave Circuit Simulation". IEEE Transactions on Microwave Theory and Techniques, Vol. 45, Issue 5, May 1997. pp. 587-592).

Claims 9-12, 14, 27-30 and 32 are rejected under 35 USC §103(a) as being unpatentable over Purks (U.S. Patent No. 5,481,695) in view of Carlson et al. (U.S. Patent No. 6,128,769) and further in view of Huang (U.S. Patent No. 5,568,395).

As already mentioned above, independent claims 1 and 19 are patentably distinguished over Purks and Carlson. All claims dependent thereon, by virtue of inherency, are also patentably distinguished over Purks and Carlson further in view of whatever other secondary reference.

Reconsideration and withdrawal of this rejection are respectfully requested.

Prior Art Indicated To Be Pertinent To The Disclosure

The Office has provided a list of prior art indicated to be pertinent to the Applicant's invention. Consistent with the understanding as stipulated in MPEP 706.02 that only the best prior art should be applied, this list of prior art not having been applied by the Office, it is the Applicant's understanding that the Office must have considered the listed prior art to be no more pertinent than the applied prior art of record.

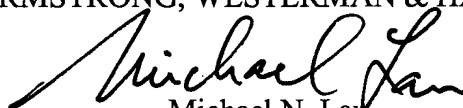
Conclusion

In view of the aforementioned amendments and accompanying remarks, all pending claims are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,
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